

## REMARKS

Claims 1-7 are presented for examination with Claims 1-7 being currently amended.

Claims 1-7 have been amended to delete repetitive portions. Claim 1 has also been amended to respond to move portions of the claim language to respond to an indefiniteness rejection. Claim 2 has been amended to recite “in which the polyamide acid is dissolved” and recite antecedent support for a “good solvent”. Support for all the amendments is found in the claims themselves as originally filed. No new matter within the meaning of § 132 has been added by the amendment.

A §1.132 declaration is submitted showing that the subject matter in “Preparation of poly(amic acid) nanoparticles using the reprecipitation method and their imidization”, Kobunshi Ronbunshu (October 25, 2002), Vo. 59(10), pages 637-641 (“Suzuki *et al.*”) and Japan Chemical Society 82<sup>nd</sup> Autumn forum (2002), Abstract 2B7-10, September 25, 2002, (“Mitsui *et al.*”) relied upon to make the outstanding § 103 rejections is the inventors’ own invention, and therefore not § 102(a) prior art. Additionally, a certificate of publication is submitted showing that Suzuki *et al.* was published on October 25, 2002 (English translation attached).

### **Objections to Specification**

The Office Action objected to the Abstract because it contains more than 150 words. The text of the abstract has been amended to be under 150 words.

The Office Action objected to the term “good solvent” because antecedent basis as to its

role in the invention is allegedly not provided. Although the “good solvent” appears for the first time on page 4, lines 4-5, one of ordinary skill would understand that the “good solvent” is what the polyamide acid and alkali metal salt are initially dissolved into, before being added to the “poor solvent” regardless of its relative position in the specification. The objection is traversed.

The Office Action noted that ACRYDIC should be capitalized wherever it appears in the specification and be accompanied by the generic terminology. The generic terminology is provided in the specification at page 5, ¶ 2, disclosing that ACRYDIC is a kind of polyacrylic acid ester. The requested capitalizations have been made where appropriate in the specification.

The Office Action objected to “constition” on page 6, line 14. The term has been deleted.

### **Claim Objections**

The Office Action objected to Claims 2, 4 and 6-7 due to repetitive language restating parts of Claim 1 with no further modification. The Office Action suggested that all material starting from “after” in line 1, continuing through “maintained” in line 5 should be removed. The requested deletions of repetitive language have been made.

### **§ 112, ¶ 2 indefiniteness rejection**

The Office Action rejected Claims 1-2, 4 and 6-7 as being narrative and indefinite. For Claim 1, the Office Action alleged that the language regarding chemical concentrations in lines 2-5 is not sufficiently clear, and assumed for purposes of examination that the intended meaning is that a polyamide acid polymer solution contains “0.5 to 80 weight % of alkali metal salt” and that this polymer solution is added to a poor solvent to make an intermediate mixture with “0.1 to

15 weight% concentration” of the polymer solution in the poor solvent. In this case, the rejection is traversed because presently amended Claim 1 recites forming polyamide acid microparticles by pouring a polymer solution prepared by dissolving polyamide acid containing 0.5 to 80 weight % of alkali metal salt into a poor solvent selected from the group consisting of aliphatic solvents, alicyclic solvents, aromatic solvents, CS<sub>2</sub> and mixture of two or more of these solvents to form a polyamide acid concentration of 0.1 to 15 weight %.

The Office Action rejected Claims 2, 4 and 6-7 because there is allegedly no antecedent support for the term “good solvent”. Claim 2 has been amended to recite “a good solvent”, hence antecedent support is provided.

### **35 U.S.C. § 103 obviousness rejection**

The Office Action rejected Claims 1-7 as being unpatentable over “Preparation of poly(amic acid) nanoparticles using the reprecipitation method and their imidization”, Kobunshi Ronbunshu (2002), Vo. 59(10), pages 637-641 (“Suzuki *et al.*”) in view of Japan Chemical Society 82nd Autumn forum (2002), Abstract 2B7-10 (“Mitsui *et al.*”). In this case, the rejection is traversed because neither reference can be used against the pending claims. Suzuki *et al.* was published on October 25, 2002 as evidenced by the certificate of publication submitted herewith. Hence, the reference is not §102(b) art. Moreover, the attached §1.132 declaration shows that the reference is not by another and therefore not art under §102(a). Similarly, Mitsui *et al.* was published on September 25, 2002, and is therefore not §102(b) art. The §1.132 declaration also shows that the reference is not by another.

Response to Office Action of 9/4/2008  
Atty Docket No: TAN-352  
Nakanishi *et al.*

In light of the foregoing, it is submitted that the application is now in condition for allowance. It is therefore respectfully requested that the rejection(s) be withdrawn and the application passed to issue.

Respectfully submitted,  
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